

REMARKS/ARGUMENTS

The examiner indicated that the Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 USC 103(c) and potential 35 USC 102(e), (f), or (g) prior art under 35 USC 103(a). The examiner has now repeated this statement in every single office action sent to the Applicant. The Applicant, having read 37 CFR 1.56, remains unaware of any such obligation.

Claim amendment

In claims 1, 10, and 30-36, the phrase “solvent system” has been amended to read “mutual solvent system”. In claim 1, the phrase “consisting essentially of” has been replaced with “comprising”.

Claims 14, and 16-17 have been rejected under 35 USC 112, second paragraph, as being indefinite. Applicants respectfully traverse this rejection.

The examiner has indicated that the concentration of the acid in the aqueous acid is indefinite, and would only be interpreted as 15 wt%. The Applicant notes that paragraph 10 states that “An aqueous acid may be added to the solvent system.” The same paragraph then goes on to give an example of 15 wt% acid. The examiner appears to have taken the 15 wt% acid, provided for example purposes only, as the only acid concentration possible for the aqueous acid.

The Applicant submits that the statement in paragraph 10 is clear on its own, and further within the context of the application itself, as providing for any suitable aqueous acid, and with any suitable acid concentration. Paragraph 1 provides examples of aqueous acids that include hydrochloric acid, hydrofluoric acid, acetic acid, and the like. These examples are in no way limiting to the scope of what is meant by an aqueous acid. A worker skilled in the art would understand that each of these types of aqueous acids would generally be used with different acid concentrations. The same worker would also understand that, for any given acid, there would be

a range of acid concentrations that would be effective. Therefore, a worker skilled in the art would understand what is meant by an aqueous acid, and claims 14, and 16-17 are not indefinite.

Similarly, the use of the term “aqueous acid” in claims 1, 10, and 30-36 is also not indefinite.

Claims 1, 10, and 30-36 have been rejected under 35 USC 103(a) as being unpatentable over Watkins. Applicants respectfully traverse this rejection.

The examiner has mistakenly chosen to focus on the foaming components of the Watkins reference with regards to this rejection. The examiner has indicated that the Applicant has the burden of showing that the foaming agents materially affect the compositional properties, and that the Applicant has not met their burden. Further, the examiner has stated that the Applicant’s assertion that the claims exclude the foaming components of the Watkins reference has not been deemed persuasive.

With respect, the Applicant submits that discussion of the foaming agent altogether with respect to patentability is irrelevant. Watkins teaches that the purpose of the foaming agent is to minimize the liquid volume required, and reduce the density, of the treating fluid (column 1, lines 49-51). Therefore, a worker skilled in the art would understand that Watkin’s treating fluid would accomplish its purpose irrespective of the presence of a foaming agent, and in an un-foamed state.

The question to be posed by this rejection is thus not whether or not the Applicant’s invention as defined by claims 1, 10, and 30-36 include or exclude a foaming agent, but whether or not the invention as defined by those claims would have been obvious to a person skilled in the art. According to the MPEP, the court in re: Hoeksema noted that once a prima facie case of obviousness is made by the PTO, the burden is on the applicant to produce contrary evidence establishing that the reference being relied on would not enable a skilled artisan to produce the invention (MPEP 2145). Therefore, in order to address the question of obviousness, it is essential

to determine whether or not such a person skilled in the art with knowledge of Watkins would be enabled to produce the Applicant's invention. This is discussed below.

The Applicant's invention as defined by claim 1, has been amended to require "a mutual solvent system". The use of the phrase "mutual solvent" indicates that the components of the solvent system form a single phase solution with one another.

Watkins, as the examiner has indicated, teaches a treating fluid that may include an organic solvent that is an alcohol, an ester, or a ketone, or a mixture thereof (column 8, lines 6-65). In addition, Watkins also teaches that most of the described organic solvents are quite immiscible with the aqueous acid components. Although Watkins points out that certain of the more polar compounds will be at least partially soluble in the aqueous component (column 8, line 66 to column 9, line 1), Watkins goes on to add that "in order that the treating composition has a substantially uniform composition, it is necessary to add an emulsifying agent to emulsify or disperse any immiscible phases" (column 9, lines 1-4, underlining added for emphasis). Similarly, each one of the independent claims describing the combination of the acid and the organic solvent teach an "immiscible organic solvent" and "an emulsifying agent" (claims 1, 14, 16, and 29). Accordingly, Watkins requires the use of an emulsifying agent to form a substantially uniform composition of oil and water phases. The Applicant submits that this is not a mutual solvent system, but a homogenous mixture at best. Therefore, it follows that a worker skilled in the art would expect that, without the emulsifying agent, the mixture would separate into its respective phases, which would be expected to vastly decrease the performance of Watkin's treating fluid in removing acid and organic soluble material. Watkins therefore teaches away from the mutual solvent system of the Applicant's invention as defined by claim 1. Watkins simply did not, by virtue of a glib indication that a mixture of organic solvents are possible, contemplate the Applicant's combination as defined by claim 1, nor did he contemplate that a mixture of an alcohol, an ester, an aqueous acid, and a solvent together would form a mutual solvent. Accordingly, it follows that a skilled artisan relying on Watkins would not be enabled to produce the mutual solvent defined in the Applicant's claim 1, and further that the

combination of elements defined by claim 1 of the Applicant's invention provides an unexpected result. Therefore, the Applicant's invention as defined by claim 1 is non-obvious.

The examiner has quoted re Kerkhoven in arguing that claim 1 is obvious. The MPEP, from which it is assumed the examiner obtained the Kerkhoven quote, reads as follows with regard to Kerkhoven: "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." (MPEP 2144.06). The Applicant submits that the principle of *prima facie* obviousness discussed in Kerkhoven can be established if the idea of combining the two ingredients flows logically from their having been individually taught in the prior art. Watkins, as described above, teaches away from forming the Applicant's combination as defined by claim 1, and further a mutual solvent system altogether. Therefore, the idea of combining the elements as required by the Applicant's claim 1 would not flow logically from the teachings of Watkins.

Reconsideration and withdrawal of the rejections, and allowance of the claims, is respectfully requested.

Respectfully submitted,



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